

In re application of: Martinez et al. § Group Art Unit: 2173
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Serial No.: 09/981,877 § Examiner: Dennis G. Bonshock
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Filed: October 18, 2001 § Attorney Docket No: AUS920010923US1
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For: METHOD OF PREVIEWING
A GRAPHICAL IMAGE
CORRESPONDING TO AN ICON
IN A CLIPBOARD

**Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF

This correspondence is a reply brief to the Examiner’s answer filed June 24, 2009. Under the Grounds of Rejection section of the Examiner’s Answer (pages 1-7), the Examiner’s remarks appear to be a substantial copy of the Detailed Action section from the Final Office Action, mailed on December 1, 2008. Hence, the following remarks are substantially directed to the Response to Argument section of the Examiner’s Answer (pages 8-18).

Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. §102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193 (Fed. Cir. 1983).

Claim 17 recites, in part:

displaying the **clipboard adjacent a display position indicator**, if it is determined a plurality of objects are within the clipboard; and
removing the clipboard from a display in response to movement of the
display position indicator not adjacent to the clipboard.

(Claim 17, emphasis added.)

The Examiner, on page 11 of his answer, misunderstands the scope of claim 17, and expands the scope beyond a broadest *reasonable* interpretation. There, the Examiner states, “given the claim language, for the claim to be satisfied it only requires a movement not adjacent to the clipboard to cause removal.” (Answer, page 11).

If this assertion were true, then the first movement not adjacent to the clipboard would cause removal, as would the second movement not adjacent to the clipboard, as would the third, and so-on and so-forth. Plainly, this line of reasoning is unreasonable, and wholly improper.

The claim states that the clipboard is removed in the first movement not adjacent to the clipboard, after following the steps earlier recited in the claim. In other words, the transition from adjacent to not adjacent is the trigger, and not merely moving the display position indicator between two positions that both are not adjacent.

The Examiner asserts, strangely, that the claim requires movement between mere non-adjacent positions to cause removal – thus ignoring that to prove anticipation, the prior art elements must be *arranged as in the claim*, which is wholly improper.

Accordingly, for the reason that the Examiner believes in the incorrect claim scope interpretation, the Examiner also believes that “it was agreed to by the applicants representative that through specific movements of a cursor off of the clipboard[,] the clipboard was removed from display”, is sufficient to teach the claim 17 recited, “removing the clipboard from a display in response to movement of the display position indicator not adjacent to the clipboard”. Accordingly, the Examiner confuses second, third, and subsequent movements, all not adjacent the clipboard, as each being sufficient, by themselves, to teach the operation of the fourth claim element. In other words, the Examiner asserts that movement from a location not adjacent to locations not adjacent is a direct cause to remove of the clipboard, according to the Examiner’s interpretation of claim 17.

Rather, Appellants contend that a correct and reasonable interpretation to claim 17 is that it is *only* the first movement not adjacent to the clipboard that operates as the *trigger* to cause the clipboard to be removed, following the prerequisite steps:

- receiving a paste command;
- determining whether a plurality of objects are stored within the clipboard
- in response to the paste command.

(Claim 17, in part)

Applying the correct interpretation to the claims, the Affidavit (Answer page 12, referencing, Anthony Champion, page 32 of Appeal Brief) is consistent with the Appellants position, that MSWord teaches, at best, changes to the clipboard when the display position indicator is moved from a first position *not adjacent to the clipboard* to a second position *not adjacent to the clipboard*. As such, when Anthony Champion states, “I can make the clipboard disappear by first placing the cursor over ‘Items’”, he states that the cursor is in a position *not adjacent to the clipboard*. Secondly, when Anthony Champion states, “and then moving left”, he is describing movement to a second position *not adjacent to the clipboard*. Accordingly, when the MSWord clipboard subsequently disappears, it is in response to a movement across a menu boundary **105**, as explained further in Appeal Brief page 11, paragraph 1. Appellants urge that the Examiner has failed to prove by a preponderance of the evidence that the movement across the menu boundary is also a movement from a position adjacent to the clipboard to a position that is not adjacent to the clipboard, in the manner claimed.

Regarding claims 1-3 and 9-11, and the Examiner’s recurring reliance (Answer, pages 15 and 17) on *Foster* column 7 line 56 through column 8, line 15 (Figure 4e-4f), the Examiner shows *Foster* only describing the process by which a clipboard is created. Such a teaching does little to teach the limitations of the claim, as the clipboard is present within the preamble of the claim.

As to the recurring reliance (Answer, pages 15 and 17) on *Foster* column 9 lines 44-65 (Figure 5C), the Examiner merely shows operation of the clipboard representing text being re-displayed as text. Entirely absent from each of these passages is a description of a preview instruction prompting a display of a *graphical image* associated with the icon in the manner claimed.

Accordingly, for the above reasons and for the reasons set forth in the Appeal Brief, it is respectfully requested that the Final Rejection be reversed, and that claims 1-3, 9-11, and 17 be found in a condition for allowance.

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